

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 10/761,894 Confirmation No.: 4218

Applicants : Richard Paul WHITE, *et al.*

Filed : January 20, 2004

Title : AN UNSOLICITED MESSAGE INTERCEPTING
COMMUNICATIONS PROCESSOR

TC/Art Unit : 2144

Examiner: : Paul H Kang

Customer No. : 36,215

Docket No. : 012-CON1

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO EXAMINER'S AMENDMENT

Dear Sir:

In response to the Examiner's Amendment and Notice of Allowance mailed on October 6, 2009, Applicant submits the following remarks.

Enclosures

- PTOL-85B Form

(37 C.F.R. §1.8a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being transmitted to the USPTO via the EFS-Web electronic filing system or Facsimile (571-273-8300) on the date set forth below.

Haw-minn Lu

Name of Person Transmitting Paper

January 4, 2010

Date of Transmission

/Haw-minn Lu/

Signature of Person Transmitting Paper

REMARKS

In response to the Examiner's Amendment mailed on October 6, 2009, Applicant respectfully makes the following remarks of record.

I. Interview

Applicant thanks Examiner Kang for contacting the Applicant and for his guidance in expediting the allowance of the present application.

II. Examiner's Amendment

As already stated in the Examiner's Amendment, Applicant has telephonically agreed to the amendments listed. However, Applicant notes for the record that claims 18 and 19 as originally presented were initially allowed and were never formally rejected, but were only cancelled at the request of the Examiner. Applicant agreed to the cancellation of the claims in order to expedite the allowance of the present application, but reserves the right to pursue the cancelled claims in a continuation application.

III. Double Patenting Rejections

In order to expedite the allowance of this application, Applicant has filed a terminal disclaimer. However, Applicant reiterates that the filing of the terminal disclaimer to obviate the double patenting rejection is not an admission of the propriety of the rejection. *See Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991) ("filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection.").

In fact, to the contrary, Applicant submits for the record that the present application is patentably distinct from United States Patent Application No. 10/761,883, United States Patent Application No. 10/761,864, and United States Patent Application No. 10/972,765. More specifically, all claims in U.S. Patent Application No. 10/972,765 recite the limitation, "terminate the mail transfer session with the sending MTA by sending an error message in accordance with the email delivery protocol, the error message comprising a reprieve message" or some variant. The present application does not claim any limitations directed to an error message comprising a reprieve message. With regard to U.S. Patent Application No. 10/761,883, now U.S. Patent No. 7,490,128, which issued on February 10, 2009, with a single claim. Comparison of that claim with any claim in the present application shows the single claim

contains a large number of limitations not recited in any claim in the present application. With regard to U.S. Patent Application No. 10/761, 864, claim 1 of the present application and claim 1 of the '864 application are directed to a different intercepting means. The intercepting means in the present application intercepts a “.r\n” end-of-message indicator reply, whereas the intercepting means in the '864 application intercepts the RCPT reply. In the former case (present application), the intercepting means rejects an unsolicited message by sending an error reply to MTA_0, whereas in the latter case, the RCPT reply to MTA_1 is modified thereby diverting the unsolicited message. The actions are completely different, in the former case the message is ultimately not received and in the latter case the message is diverted to an alternate email account. Similarly, a comparison of similar claims in the '864 application and the present application show similar patentable distinction.

IV. Conclusion

An issue fee of \$755 was mailed on February 20, 2009 and received by the U.S. Patent & Trademark Office on February 25, 2009. According the current fee schedule, the issue fee at present has remained at \$755. Therefore, Applicant believes no additional fee is due. Therefore, the submission of the PTOL-85 form is believed to place this application in condition for issuance.

No fee is believed to be necessary for entry and consideration of this Reply. In the event that a fee is due and required by the U.S. Patent & Trademark Office to issue the present application, or to keep the present application from being abandoned, please immediately contact the undersigned to remedy such deficiency.

Respectfully submitted,

By: /Haw-minn Lu/
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January 4, 2010

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